

REMARKS

On October 31, 2003, the Examiner mailed an Office Action, finally rejecting pending claims 1-31. On December 31, 2003, Applicants submitted a Response to the Final Office Action. The Examiner mailed an Advisory Action on January 26, 2004. In response to the Final Office Action and the Advisory Action, Applicants filed a Notice of Appeal on March 1, 2004 and filed an Appeal Brief on May 4, 2004. In view of the Appeal Brief, the Examiner provided the present Office Action and re-opened prosecution of the application. In the present non-final Office Action, pending claims 1-31 were rejected. The Examiner's rejections are identical to those previously provided in the Final Office Action mailed on October 31, 2003. In addition, the Examiner objected to the drawings under 37 C.F.R. § 1.83(a) and objected to claim 3 under 37 C.F.R. § 1.75(c). In the present response, Applicants have addressed the new objections to the drawings and the claims, as further discussed below. In view of the identical rejections provided in the instant Office Action, Applicants hereby resubmit the arguments provided by Applicants on December 31, 2003 in the present response. Applicants respectfully request reconsideration of the claims in view of the remarks set forth below.

Objections to the Drawings

The Examiner objected to the drawings under 37 C.F.R. § 1.83(a) for failing to show every feature in the claims. Specifically, the Examiner stated:

“***third memory device***” (on the main unit as claimed in claims 1 and 15) must show or the feature(s) canceled from the claim(s). No new matter should be entered.

“***memory***” (on the main unit as claimed in claims 20-21) must be shown or the feature(s) canceled from the claim(s). No new matter should be added.

Applicants have submitted a replacement drawing for Fig. 2, attached hereto as “Appendix A.” The replacement drawing illustrates a “memory 63.” Further, Applicants

have provided a replacement paragraph, as set forth above, to describe the additional element. As appreciated by those skilled in the art and as discussed throughout the application, a system, such as the main unit 10, includes a system memory for storing applications, drivers and data. The amended drawing and specification are submitted to provide further illustration and clarification of the subject matter already described throughout the application at the time of filing. Applicants respectfully submit that no new subject matter has been added by the replacement drawing or the replacement paragraph. Applicants submit that the submission of the replacement drawing and replacement paragraph is sufficient to overcome the Examiner's objection to the drawings. Accordingly, Applicants respectfully request that the Examiner withdraw his objections under 37 C.F.R. § 1.83(a).

Objections to the Claims

The Examiner claim 3 under 37 C.F.R. § 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Specifically, the Examiner stated:

“the first memory device and the second memory device comprise the same memory device” fails to further limit the subject matter “the first memory device and the second memory device.”

Applicants respectfully traverse the Examiner's objection. Specifically, independent claim 1 recites “a first memory device,” and “a second memory device.” Claim 3 provides the further limitation that the first memory device and the second memory device are “the same memory device.” In accordance with the scope of claim 1, the first memory device and the second memory device may be separate devices. The scope of claim 3 is limited to an embodiment where the first and second memory devices comprise a single memory device. Because the subject matter additionally recited in claim 3 further limits the subject matter

recited in claim 1, Applicants respectfully submit that the claim is fully compliant with 37 C.F.R. § 1.75(c), as presently presented. Accordingly, Applicants request withdrawal of the Examiner's objection under 37 C.F.R. § 1.75(c).

Rejections under 35 U.S.C. § 102

The Examiner rejected claims 1, 3-8, 11 and 24-28 under 35 U.S.C. § 102(e) as being anticipated by Harari et al. (U.S. Pat. No. 6,266,724). With regard to the independent claims, the Examiner stated:

As to claim 1, Harari teaches a method of implementing a personal digital assistant comprising a main unit (host system 200 and/or mother card 10) and an option pack (daughter card 20) (Fig. 1) comprising the acts of: (a) coupling the option pack with the main unit (Fig. 1), the option pack comprising a first memory device (memory in the daughter card) configured to store one or more applications and drivers associated with the one or more applications (col. 10, lines 37-47 and col. 13, lines 10-20), and a second memory device (part of the memory in the daughter card) configured to store identification data (configuration and device specific information) (col. 8, lines 51-55), the main unit comprising a device manager (comprehensive controller) configured to receive the identification data from the second memory device (col. 8, lines 38-55), a power supply (col. 7, lines 55-61), and a third memory device (ROM 52) (col. 7, lines 46-61); (b) transmitting the identification data from the second memory device to the device manager (col. 8, lines 51-55); and (c) downloading the one or more applications, as well as drivers associated with the one or more applications, from the option pack to the main unit (col. 10, lines 37-47 and col. 13, lines 10-20).

As to claim 24, Harari teaches an option pack interface comprising: a memory device (memory in the daughter card) comprising a memory data structure configured to store identification data (configuration and device specific information) (col. 8, lines 51-55), and at least one data sector defined within the memory data structure (part of the memory in the daughter card), wherein the at least one data sector comprises one or more applications, as well as drivers associated with the one or more applications (col. 10, lines 37-47 and col. 13, lines 10-20), and wherein the one or more applications and drivers are

configured to be downloaded from the memory device to a main unit (col. 10, lines 37-47 and col. 13, lines 10-20).

Applicants respectfully traverse this rejection. Anticipation under Section 102 can be found only if a single reference shows exactly what is claimed. *Titanium Metals Corp. v. Banner*, 778 F.2d 775, 227 U.S.P.Q. 773 (Fed. Cir. 1985). For a prior art reference to anticipate under Section 102, every element of the claimed invention must be identically shown in a single reference. *In re Bond*, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990). To maintain a proper rejection under Section 102, a single reference must teach each and every element or step of the rejected claim. *Atlas Powder v. E.I. du Pont*, 750 F.2d 1569 (Fed. Cir. 1984). Thus, if the claims recite even one element not found in the cited reference, the reference does not anticipate the claimed invention.

The present application is directed to a personal digital assistant (PDA) having a main unit and an option pack. The option pack includes one or more applications, as well as drivers associated with the one or more applications. The software applications and software drivers are stored on the option pack to conserve memory on the main unit and to eliminate the process of downloading software from the Internet or a CDROM. Page 7, lines 11-14. Once an option pack is inserted into the main unit and the option pack is identified, the main unit determines whether it has enough battery life to power the option pack and determines whether it has enough memory space to download the applications and drivers from the option pack to the main unit. Page 26, lines 5-8; page 26, lines 14-16; page 27, lines 4-8. Once the main unit obtains the information on the drivers and applications, and determines that it has enough memory to accommodate the applications and drivers, the applications and drivers are downloaded from the option pack to the main unit. Page 27, lines 8-16.

Accordingly, claim 1 recites a method comprising “downloading the one or more applications, as well as drivers associated with the one or more applications from the option pack to the main unit.” Claim 24 recites an option pack interface having at least one data sector, “wherein the at least one data sector comprises one or more applications, as well as drivers associated with the one or more applications, and wherein the one or more applications and drivers are configured to be downloaded from the memory device to a main unit.”

In contrast, the Harari reference discloses a system for implementing mass storage peripherals, such as electrically erasable programmable read-only-memories (EEPROM) or flash EEPROMs. Col. 1, lines 20-22. More specifically, a peripheral card having a PC card form factor, and which may include flash EEPROM chips, is removabley coupled to a mother card. Abstract. The Examiner correlated daughter cards 20 of Harari with the presently recited option pack. In the Office Action, the Examiner cited col. 10, lines 37-47 and col. 13, lines 10-20 as disclosing the act of downloading one or more applications, as well as drivers associated with the one or more applications, from the option pack to the main unit, as recited in claim 1. Similarly, the Examiner cites the same passages in support of his assertion that Harari teaches an option pack interface wherein one or more applications and drivers are configured to be downloaded from a memory device on the option pack to the main unit, as recited in claim 24. Applicants respectfully traverse this assertion.

The first passage discloses a controller on the mother card 10 which is configured to read and write to the daughter card 20. Col. 10, lines 43-45. The controller on the mother card 10 may, for example, read different application programs on the daughter card 20. Col. 10, lines 45-47. The second passage discloses storing a key or algorithm on the daughter card 20 wherein the key is used to recover data stored on the daughter card 20. Col. 13, lines 10-15.

When the daughter card 20 is relocated from one host to another, the decoding information is available on the daughter card 20.

While these passages may disclose *reading* application programs from a daughter card 20 and the *availability* of a decoding key or decoding algorithm on the daughter card 20, nothing in the Harari reference discloses *downloading* one or more applications and drivers associated with those applications from an option pack to a main unit as recited in the present claims. As a preliminary matter, Applicants traverse the Examiner's characterization of the mother board 10 and the daughter board 20 as the main unit and option pack recited in the present application. Those skilled in the art would not correlate the mother board 10 and daughter board 20 of a personal computer system, as disclosed in Harari, with the main unit and option pack of a personal digital assistant, as presently recited, within the broadest reasonable interpretation. Regardless, Applicants further assert that even if such a characterization could reasonably be made, and even if the mother card 10 is capable of reading different application programs on the daughter card 20 or accessing drivers on the daughter card 20, the applications and drivers *are not* downloaded to the mother card 10. As clearly stated in the Harari reference, any applications and/or drivers are simply read or made accessible by the mother board. Accordingly, the Harari reference does not disclose every element recited in the present claims and therefore cannot possibly anticipate the recited subject matter.

In view of the remarks set forth above, Applicants respectfully submit that the subject matter disclosed in the Harari reference does not anticipate the subject matter of independent claims 1 and 24. Therefore, Applicants respectfully request withdrawal of the Examiner's rejection and allowance of claims 1, 3-8, 11 and 24-28.

Rejections under 35 U.S.C. § 103

The Examiner rejected claims 17 and 22 under 35 U.S.C. § 103(a) as being unpatentable over Postman et al. (U.S. Pat. No. 5,664,231) in view of Harari et al. (U.S. Pat. No. 6,266,724). Specifically with regard to independent claim 17, the Examiner stated:

As to claim 17, Postman teaches a method of interfacing an option pack (PC card) with a min unit of a personal digital assistant (PDA), comprising the acts of: (a) determining whether there is an option pack coupled to the main unit (automatically apply power to the input device when the PC Card is inserted) (col. 26, lines 48-48-50); (b) providing an interrupt signal from the option pack to the main unit; (c) interrupting the processing of the main unit; (d) notifying the main unit that the option pack is present (col. 26, lines 50-54 and col. 7, lines 1-5); and (e) transmitting identification information (Configuration Option/Card Configuration Status Register) from the option pack to the main unit (col. 8, lines 43-54). However, Postman does not explicitly disclose copying one or more applications, as well as drivers associated with the one or more applications, from the option pack to the main unit. Harari teaches option pack having applications and drivers associated with the applications, and teaches copying the applications and drivers from the option pack to the main unit (col. 10, lines 37-47 and col. 13, lines 10-20). It would have been obvious to one of ordinary skill in the art at the time the invention was made to implement including applications and drivers associated with the applications in the option pack, and copying the applications and drivers from the option pack to the main unit as taught by Harari in the system of Postman to add different specific functions (programs) to the system at any time.

Applicants respectfully traverse this assertion. The burden of establishing a *prima facie* case of obviousness falls on the Examiner. *Ex parte Wolters and Kuypers*, 214 U.S.P.Q. 735 (PTO Bd. App. 1979). Obviousness cannot be established by combining or modifying the teachings of the prior art to produce the claimed invention absent some teaching or suggestion supporting the combination or modification. *See ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 U.S.P.Q. 929, 933 (Fed. Cir.

1984). Accordingly, to establish a *prima facie* case, the Examiner must not only show that the combination includes *all* of the claimed elements, but also a convincing line of reason as to why one of ordinary skill in the art would have found the claimed invention to have been obvious in light of the teachings of the references. *Ex parte Clapp*, 227 U.S.P.Q. 972 (B.P.A.I. 1985).

Claim 17 recites “copying one or more applications, as well as drivers associated with the one or more applications, from the option pack to the main unit.” The Examiner cites the Harari reference as disclosing the aforementioned features. As discussed above with regard to independent claims 1 and 24, the Harari reference does not disclose downloading or copying applications and drivers from an option pack to a main unit. The Postman reference simply discloses a PCMCIA card which is not configured to store one or more applications and associated drivers. Accordingly, the Postman reference does not cure the deficiencies of the Harari reference. Because neither of the references either alone or in combination discloses each of the elements recited in the present claims, the references cannot possibly render the claimed subject matter obvious. Accordingly, Applicants respectfully request withdrawal of the Examiner's rejection and allowance of claims 17 and 22.

The Examiner rejected claim 2 under 35 U.S.C. § 103(a) as being unpatentable over Harari in view of Bailey et al. (U.S. Pat. No. 6,134,612). The Examiner rejected claims 9 and 30 under 35 U.S.C. § 103(a) as being unpatentable over Harari in view of Garney (U.S. Pat. No. 5,538,436). The Examiner rejected claims 12-14 under 35 U.S.C. § 103(a) as being unpatentable over Harari in view of Miller (U.S. Pat. No. 6,199,168). The Examiner rejected claim 15 under 35 U.S.C. § 103(a) as being unpatentable over

Harari in view of Kane et al. (U.S. Pat. No. 5,652,832). The Examiner rejected claims 10, 16, 29 and 31 35 U.S.C. § 103(a) as being unpatentable over Harari in view of Petty (U.S. Pat. No. 6,389,486). The Examiner rejected claims 18 and 19 under 35 U.S.C. § 103(a) as being unpatentable over Postman in view of Harari and further in view of De Nicolo (U.S. Pat. No. 6,308,240). The Examiner rejected claims 20 and 21 under 35 U.S.C. § 103(a) as being unpatentable over Postman in view of Harari and further in view of Kane. The Examiner rejected claim 23 under 35 U.S.C. § 103(a) as being unpatentable over Postman in view of Harari and further in view of Cepulis (U.S. Pat. No. 6,055,596). The Examiner's rejections are too lengthy to be reproduced efficiently herein. However, Applicants respectfully traverse each of the Examiner's rejections.

As discussed above with regard to the rejections under 35 U.S.C. § 102, the Harari reference does not disclose all of the elements recited in independent claims 1 and 24. Further, as discussed above, neither the Harari reference nor the Postman reference discloses all of the elements recited in independent claim 17. Each of the present rejections under 35 U.S.C. § 103 cite either Harari or Postman as the primary reference for the rejections of the various dependent claims. Applicants respectfully submit that none of the cited references cure the deficiencies of the Harari and Postman references, as discussed above with respect to the independent claims. Accordingly, Applicants submit that none of the prior art references either alone or in combination discloses all of the elements recited in the present claims. Applicants respectfully request withdrawal of the Examiner's rejections under 35 U.S.C. § 103(a) and allowance of claims 2, 9, 10, 12-16, 18-23, 30 and 31.

Conclusion

In view of the remarks and amendments set forth above, Applicants respectfully request withdrawal of the Examiner's rejections and allowance of claims 1-31. If the Examiner believes that a telephonic interview will help speed this application toward issuance, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,



Date: November 19, 2004

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IN THE DRAWINGS

Please amend the drawings to include “memory 63.” A replacement drawing is attached hereto as Appendix A.